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09/714,715REMARKS

The rejection of claims 1-4, 7-11, and 14-21 as being unpatentable under 35 USC 102(e) as anticipated by Lisle et al. (US6,069,630) is respectfully traversed.

Lisle et al. fails to Anticipate Claims 1-4, 7-11, and 14-21 under 35 USC 102(e).

It is submitted that a rejection based on anticipation under 35 U.S.C. 102, must expressly or impliedly teach every element of invention without modification. The Examiner's application of the Lisle patent does not meet this standard.

The primary element that the present claimed invention and the Lisle patent have in common is that they both relate to World Wide Web pages. There the similarity ends. The present invention provides an aid to a user who is browsing or searching the Web i.e. backtracking through where he has been and passed through in his navigation on the Web in a particular session. On the other hand, Lisle provides a graphical display interface to aid a Web page designer to create and edit a Web page.

This invention does the tracking of a browsing session by starting with a starter received Web document, and then selecting a set of subsequently received Web documents as a set of subsequent or next documents. There are means for creating a hyperlink in each of the starter and next documents respectively to their next document in the set. The actual and received starter and next documents are stored at the receiving display station to thereby store a selected string of linked actual Web documents or pages at the receiving station.

Lisle fails to disclose at least two elements of the claimed invention: the selected starter Web pages and next

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2

PATENT
09/714,715

Web pages are not actually stored at the receiving Web station. Col 1, lines 37-48 (Lisle) cited by Examiner sets forth that bookmarks identifying URLs (addresses) of the selected Web pages or documents are stored in an HTML files at the selection site. The bookmarks and the URLs are just the addresses of the selected Web pages. The actual Web pages or documents in Lisle are still stored at their original addresses, and must be fetched from such addresses rather than being stored along with the other Web documents in the string at the receiving display station at which the set of hyperlinked Web documents was created as in the present invention.

Also, Lisle fails to disclose a stored sequence or string of Web documents extending from a selected starter Web document with a hyperlink in each Web document in the string linking to the next Web document in the sequence.

For this teaching in Lisle, the Examiner points to Col 7, lines 26-27 which appears to be some vague reference to a default condition resulting in the creation of a new workspace if the user does not wish to revise an existing document or workspace. It is submitted that such a remote statement can not be specific enough to meet the above mentioned requirements of 35 U.S.C. 102, to expressly or impliedly teach every element of invention without modification. This cited section of Lisle does not teach means for creating a hyperlink in said starter document to said first next document, or (as in claim 2 herein) means for creating a hyperlink in said first next document to a subsequent next document.

Claim 2 covers a stored sequence or string of subsequent Web documents each linked to the next through created hyperlinks. This claim is submitted to be patentable over Lisle for all of the reasons set forth

AUS920000748US1

3

PATENT
09/714,715

hereinabove. In this connection, the Examiner appears to be placing some special reliance on the use of the term "URL string" (col 1, lines 37-48). From the context of this section, it is clear that this is not a reference to any kind of string or sequence of linked Web documents but rather "URL string itself" as used in the section merely refers to the string of alphanumeric characters making up the URL (address) itself. This terminology is ambiguous and is not clear enough to contribute anything to the specific teaching required for a 35 USC 102 rejection.

In addition, dependent claims 4, 11, and 18 each contain the additional element that the hyperlink created in each Web page to next Web page in the selected sequence is visually distinct from the other hyperlinks in the Web page. This is not taught by anything in Lisle.

Applicants have established that Lisle can not be used as a reference under 35 USC 102(e) because it does not teach every element of the claimed invention in unmodified form. Lisle clearly fails to meet the standard for anticipation under 35 U.S.C. 102(e), wherein the reference must expressly or impliedly teach every element of invention without modification. Thus, it is submitted that significant modifications would have to be made in the Lisle teaching to even have any suggestion of the present invention.

However, it should be noted that since the present Application and the Lisle Patent reference were commonly owned by International Business Machines Corporation, the Assignee herein at the time the invention of the present Application was made, the Lisle patent can not be used to preclude patentability based upon 35 U.S.C. 103(c). Thus, in the present rejection, the disclosure of Lisle can not be modified so as to develop an obviousness rejection under 35 USC 103.

AUS920000748US1

4

PATENT
09/714,715

The rejection of claims 5-6, and 12-13 under 35 USC 103(a) over the combination of Lisle et al. (US6,069,630) in view of Nielsen (US6,021,435) is also respectfully traversed.

The Lisle et al. Patent is Owned by the Assignee of the Present Application, and Thus Can Not Preclude Patentability Under 35 U.S.C. 103(c).

The present Application and the Lisle Patent reference were commonly owned by International Business Machines Corporation, the Assignee herein at the time the invention of the present Application was made.

The file of the present Application indicates that an Assignment of the present Application to said Assignee is filed in the Patent Office. Also the printed Lisle et al. Patent indicates that it is assigned to the same Assignee.

Since the present Application has a filing date after November 29, 1999, and the Lisle et al. Patent does qualify as prior art under the provisions of 35 U.S.C. 102(e), it is submitted that the lisle patent can not be used to preclude patentability based upon 35 U.S.C. 103(c). [Examiner's attention is directed to MPEP Sections [706.02(1); (1)(1); (1)(2); and (1)(3).]

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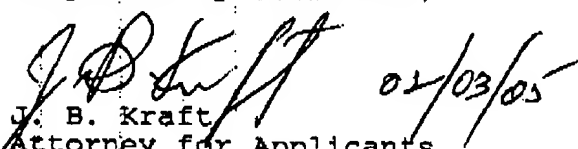
5

PATENT
09/714,715

Accordingly, Examiner is respectfully requested to withdraw Lisle et al. as a reference in this 35 USC 103(a) rejection. Without Lisle et al. there is no basis for the rejection of claims 5-6, and 12-13.

In view of the foregoing, claims 1-21 are submitted to be in condition for allowance, and such allowance is respectfully requested.

Respectfully submitted,

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AUS920000748US1

6

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